UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,833	07/15/2002	Arthur P. Hansen	056118-5001	2327

9629 7590 04/23/2004

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER	
PRATT, HELEN F	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/049,833	HANSEN, ARTHUR P.	
	Examiner	Art Unit	
	Helen F. Pratt	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 8 are indefinite in the use of the phrase "elevated temperature and pressure". It is not known to what degree the temperatures and pressure are elevated.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Moshy (3,168,406).

Moshy discloses as in claim 11 a process for removing soy flavors from soybean flour by treating soy flour with a solvent such as ethyl alcohol to remove flavors (col. 4, lines 31-73, col. 5, lines 1-5). Claim 11 is not being interpreted to give the special meaning of the term "oat flour" as on page 2, lines 24-26, to the "soy flour" of the specification, because no reference is made to any special treatment of the soy flour as is given to the oat flour.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inglett (5,225,219).

Inglett discloses a process of treating an oat fraction with alcohol (ethanol) which will remove the flavor as the process is the same (abstract and col. 1, lines 34-38, col. 2, lines 58-65, col. 5, lines 30-70 and col. 6, lines 1-28). "Oat flour" is given particular meaning in the specification on page 2, lines 14-26, in that it is meant to be "Oatrim" TM, which is a hydrolyzed flour treated to produce a water-soluble fraction as in patents 4,996,063 and 5,082,673 (page 1 of the specification). In particularly, Inglett '219 discloses using a hydrolyzed cereal flour using alpha amylase enzymes with the separation of the soluble fiber (col. 4, lines 5-35), which is an amylodextrin (col. 4, lines 32 and 33). The amylodextrin is then treated with a solvent, which can be ethanol, which precipitates the amylodextrin faction from the water-soluble fraction (col. 4, lines 53-60). The supernate which is treated with ethanol is considered to be the product of the process of treating an "Oatrim" product as in the specification (col. 5, lines 70). Since the supernate has been treated with ethanol, it is considered to have had its flavor removed since the process is the same. Claims 1, 2 and 9 differ from the reference in that the oat flour (supernate) is treated until it is free of oat flavor. However, it is seen at this time that treating the supernate (soluble fraction) overnight,

would have removed oat flavors (col. 6, lines 20-28). Therefore, it would have been obvious to use the process of Inglett who treats an Oatrim-like product with alcohol which will also remove flavors as the process is the same.

Claim 10 is also a product by process claim. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See In re Thorpe 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See Ex parte Jungfer 18 USPQ 2D 1796. As the limitations of the process have been shown above which make the product, it is seen that the product would have been obvious as shown by the combined references.

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inglett 219 as applied to claims 1-2, 9, 10 above, and further in view of Tuschoff 4,256,509).

Claim 3 further requires that the extraction is carried out at elevated temperatures and pressure and claim 8 that the process is carried out for from 20-24 hours. Inglett '219 discloses that the hydrolyzed oat bran flour (supernate) is treated with ethanol and allowed to stand overnight (col. 5, lines 60-65). However, using elevated temperatures and pressures would only decrease the processing time. It would have been obvious to treat at higher temperatures in order to decrease the process time if desired. Tuschhoff et al. disclose modifying the characteristics of a starchy flour by treating with alcohol and heat to various temperatures and pressure.

Treating at elevated temperatures and pressures would also remove any inherent flavors as the process of treating a starch material with alcohol is the same (abstract and col. 2, lines 61-70). Therefore, it would have been obvious to use higher temperatures and pressures to increase the reaction time as disclosed by Tuschhoff.

Claims 4-6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inglett '219 as applied to claims 1-2, 9, 10 above, and further in view of Oughton (4,211,801).

Claim 4 further requires that the flour is vacuum dried. Oughton discloses that centrifuged flour is dried under a vacuum which would remove any alcohol (col. 6, lines 41-44). Even though the claimed material is not a flour, per se, but a flour fraction, it still has been treated with alcohol as in the reference and the reference discloses that it is known to remove alcohol from flour. Therefore, it would have been obvious to remove alcohol from a flour fraction using a vacuum.

Claims 5 and 6 further require that the process is carried out either continuously or batchwise. The process of Oughton can be used in either manner (col. 7, lines 10-35). Therefore, it would have been obvious to process in either manner.

Claim 7 requires that the lipids are removed from the product, filtered and that the alkanol is recycled. Oughton discloses that the lipids (fats) are removed using alcohol (col. 2, lines 54-70). Nothing new is seen in further filtering the alkanol to remove color and flavor compounds. Reuse of the oil would have been obvious since that is the function of further treating the oil. Therefore, it would have been obvious to further treat the oil as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP 4-19-04

H. Pratt

HELEN PRATT
PRIMARY EXAMINER